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In re Application of
TARACHA et al.
Application No.: 10/573,033
PCT No.: PCT/US04/30831
Int. Filing Date: 21 September 2004
Priority Date: 22 September 2003
Attorney Docket No.: 41860-229250
For: ANTIGENS FOR AN EAST COAST
FEVER VACCINE

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DECISION ON PETITION
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UNDER 37 CFR 1.497(d)
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This is a decision on applicants' "Petition to Correct Inventorship Under 37 CFR 1.48(a)", filed on 22 February 2007 in the United States Patent and Trademark Office (USPTO) and refiled on 09 April 2007. The petition is treated under 37 CFR 1.497(d) and seeks to add Elizabeth Jane Glew, Simon Graham, Nyerhovwo J. Tonukari, Yoshikazu Honda, Roger Pelle, Duncan Mwangi and Matasuke Yamage as inventors in the above referenced application. Applicant also requests a one month extension of time, which is granted.

BACKGROUND

On 21 December 2006, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration in accordance with 37 CFR 1.497(a) and (b) was required. Applicant was given two (2) months within which to respond, with extensions of time available.

On 22 February 2007, applicant filed a Response to the Notification of Missing Requirements, along with Combined Declaration and Power of Attorney executed by applicant/inventors identified in the published International application and identifying Elizabeth Jane Glew, Simon Graham, Nyerhovwo J. Tonukari, Yoshikazu Honda, Roger Pelle, Duncan Mwangi and Matasuke Yamage as co-inventors. Applicant also filed a petition to correct inventorship, treated under 37 CFR 1.497(d) requesting the addition of applicant/inventors Elizabeth Jane Glew, Simon Graham, Nyerhovwo J. Tonukari, Yoshikazu Honda, Roger Pelle, Duncan Mwangi and Matasuke Yamage.

DISCUSSION

37 CFR 1.497 (d)

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on

his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

Applicant satisfied Item (2) above. With regard to Item (1), it appears that either the attorney pieced together separate sheets of the statement into one composite statement or that the inventors were presented with an incomplete statement. While it is acceptable for applicants to execute separate copies of the statement, the entire statement, as executed by the inventor, must be submitted. Moreover, the statement identifies Nyerhovwo J. Onukari rather than Nyerhovwo J. Tonukari as corrected by the inventor.

With respect to Item (3), the written consent of the assignee Institute for Genomic Research is acceptable. However, the written consent of the assignee International Livestock Research misidentifies two inventors: inventor Jane Glew rather than Elizabeth Jane Glew and inventor Onukari, rather than Tonukari, which is listed in the inventors' statement. Thus, Item (3) is not yet satisfied.

Accordingly, applicant has met not all of the requirements of 37 CFR 1.497(d) to add Elizabeth Jane Glew, Simon Graham, Nyerhovwo J. Tonukari, Yoshikazu Honda, Roger Pelle, Duncan Mwangi and Matasuke Yamage as co-inventors in the above-identified international application.

37 CFR 1.497 (a) and (b)

The declaration filed on 22 February 2007 does not meet the requirements of 37 CFR 1.497 (a) and (b) and is unacceptable as filed. First, the declaration identifies Evans Tarcha, rather than Evans Taracha as identified on the published international application, making the declaration unacceptable.

Second, the declaration submitted on 22 February 2007 is a seven page declaration, comprised of twelve pages. The declaration contains Page 1, Page 2, Page 3, Page 7 along with three duplicate Page 4 signature pages, three duplicate Page 5 signature pages and two duplicate Page 6 signature pages. Each duplicate Page is executed by different inventors.

The declaration appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

Alterations on Declaration

Furthermore, a review of the declaration reveals that the declaration has been altered. The USPTO does not accept a declaration that has been altered.

Section 602.01 of the MPEP states the following:

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly

subscribed to, a new oath or declaration must be required....

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

The changes made in the declaration executed by inventors Graham, Nene, and Tonukari were not dated and/or initialed or signed. Therefore, a new acceptable oath or declaration executed by the inventors, in compliance with 37 CFR 1.497(a) and (b), is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Elizabeth Jane Glew, Simon Graham, Nyerhovwo J. Tonukari, Yoshikazu Honda, Roger Pelle, Duncan Mwangi and Matasuke Yamage as inventors is **DISMISSED WITHOUT PREJUDICE**.

For the reasons set forth above, the declaration submitted on 22 February 2007 is unacceptable as filed. The declaration executed by Elizabeth Jane Glew, Simon Graham, Nyerhovwo J. Tonukari, Yoshikazu Honda, Roger Pelle, Duncan Mwangi and Matasuke Yamage along with the joint inventors named in the above referenced application is unacceptable and not in compliance with 37 CFR 1.497(a) and (b). A newly executed declaration is required; either one declaration where all inventors have signed or separate complete declarations in compliance with 37 CFR 1.497(a) and (b), with the corrections as noted in the discussion above.

Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 1.497(a) and (b) within ONE (1) MONTH from the mail date of this Decision or the time remaining under the Notification of Missing Requirements.

This application will be held in the PCT Legal Office, Office of PCT Legal Administration to await applicant's further reply, that is, a newly executed oath or declaration by inventors, in compliance with 37 CFR 1.497(a) and (b).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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